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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,758	04/11/2001	William M. Jackson	82515RLO	3362

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EXAMINER

EBRAHIMI DEHKORDY, SAEID

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/832,758

Applicant(s)

JACKSON ET AL.

Examiner

Saeid Ebrahimi-dehKordy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 14-17 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 14-17 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/28/05 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 6-7, 14-17 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai et al (U.S. patent 6,167,469) in view of Baum et al (Pub. No.: US 20050264832)

Regarding claim 1, 14 and 22 Safai et al disclose: A method of ordering a photo product to be printed at a selected location and delivered to a designee comprising the steps of: (a) a user communicating with a service provider (please note Fig.6 item 100 the camera and item 602, column 13 lines 10-24 where the user pushes the button to send photos from the camera to the service provider 602) that offers a plurality of photo products and selecting a particular photo product to incorporate a digital image provided by the user (please note Fig.6 item 602 where the product selected by the user like photo album or any product, column 15 lines 14-45) (b) the user providing an

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identification of the designee's location where the selected photo product is to be delivered (please note Fig.4E &F, column 12 lines 3-35) and also Fig.6 column 13 lines 66-67 and column 14 lines 1-25). However Safai et al do not quite disclose: (c) selecting from a plurality of remote printing locations at least some of which can produce different photo products; a selected printing location based on the identification of the designee's location and the selected photo product; (d) using a communications network to transfer the digital image from the user to the selected (note page 3 paragraph 0029) printing location that can produce the selected photo products; and (e) printing the selected photo product at the selected printing location and delivering the selected photo product to the designee. On the other hand Baum et al disclose: selecting from a plurality of remote printing locations at least some of which can produce different photo products (note page 3 paragraph 0029 where the plurality of printers would be used to chose from by the recipients which prints the images associated with the recipient, in terms of the photo products, page 7, paragraph 0089 which discloses the multiple different recipients, each of whom can receive his or her own personalized set of prints in which each can be generated according to customizable parameters (e.g , size, number of copies, finish , personal message, etc.) selected printing location based on the identification of the designee's location and the selected photo product (page 7, paragraph 0089 which discloses the multiple different recipients, each of whom can receive his or her own personalized set of prints in which each can be generated according to customizable parameters (e.g , size, number of copies, finish , personal message, etc.) (d) using a communications network to transfer the digital image from

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the user to the selected (note page 3 paragraph 0029) printing location that can produce the selected photo products (note page 3 paragraph 0029 where the plurality of printers would be used to chose from by the recipients which prints the images associated with the recipient, in terms of the photo products, page 7, paragraph 0089 which discloses the multiple different recipients, each of whom can receive his or her own personalized set of prints in which each can be generated according to customizable parameters (e.g , size, number of copies, finish , personal message, etc.) and (e) printing the selected photo product at the selected printing location and delivering the selected photo product to the designee (note page 7 paragraph 0089 where the customized images or products were printed and sent to the recipients). Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Safai et al's invention according to the teaching of Baum et al, where Baum et al in the same filed of endeavor teach the way the specific image product is produced and printed to the specific recipient printer designated by the recipient for the purpose of making the process easier for the customers.

Regarding claim 2 Safai et al disclose: The method of claim 1 wherein the user makes payment via the network for the photo product (please note column 15 lines 19-26).

Regarding claim 6 Safai et al disclose: The method of claim 5 wherein the user transfers the digital image to the network address communicated by the service provider (please note column 13 lines 66-67 and column 14 lines 1-25).

Regarding claim 7 Safai et al disclose: The method of claim 1 wherein the photo product includes at least one album page (please note column 15 lines 27-30) the digital image is transferred from the user directly to the particular printing locations and album page background image data is communicated from the service provider to the particular printing location in order to produce the at least one album page (please note column 15 lines 31-45).

Regarding claim 15 Safai et al disclose: The method of claim 14 wherein the plurality of photo products is selected from a group including an album page containing two or more digital images provided by the user (please note column 15 lines 27-35).

Regarding claim 16 Safai et al disclose: The method of claim 14 wherein the plurality of photo products includes prints having a plurality of different sizes (please note column 10 lines 32-35).

Regarding claim 17 Safai et al disclose: The method of claim 14 further including the steps of a user providing a payment identifier specifying an account to be charged for producing and delivering the photo product (please note column 15 lines 16-25).

Regarding claim 23 Safai et al disclose: The method of claim 22 wherein step (f) includes printing a postage stamp on the shipping label (please note column 14 lines 38-42).

Regarding claim 24 Safai et al disclose: The method of claim 23 wherein the postage stamp depicts at least a portion of the digital image (please note column 14 lines 35-44).

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4. Claims 3-5 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai et al (U.S. patent 6,167,469) in view of Baum et al (Pub. No.: US 20050264832) and further in view of Zehr et al (Pub. No.: US 20010025274)

Regarding claims 3 and 25 Neither Safai et al nor Baum et al quite disclose: The method of claim 1 wherein the identification of the designee's location is the designee's zip code. On the other hand Zehr et al disclose: The method of claim 1 wherein the identification of the designee's location is the designee's zip code (please note page 3 paragraph 0035 lines 5-8) Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Safai et al and Baum et al's invention according to the teaching of Zehr et al , where Zehr teach the way the recipient address and zip code would be used for the purpose of getting the images to the recipients.

Regarding claims 4 and 26 and Zehr et al disclose: The method of claim 3 wherein the photo product is delivered to the designee by the U.S. postal service (please note page 2 paragraph 0031).

Regarding claim 5 Zehr et al disclose: The method of claim 1 wherein the service provider communicates a network address of the particular printing location to the user (please note page 3 paragraph 0032).

Contact Information

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (571) 272-7462.

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The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (571) 272-7471.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

Or faxed to:

(703) 872-9306, or (703) 308-9052 (for **formal** communications; please mark
"EXPEDITED PROCEDURE")


Or:

(703) 306-5406 (for **informal** or **draft** communications, please label
"PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Knox building on 501 Dulany Street, Alexandria, VA.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy
Patent Examiner
Group Art Unit, 2626
February 16, 2006


MARK WALLERSON
PRIMARY EXAMINER